| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/919,153 | 07/31/2001 | James O. Schreckengast | 10004047-1 | 3204 |

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| EXAMINER |
|---|
| WALSH, JOHN B |

| ART UNIT | PAPER NUMBER |
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| 2151 | |

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|---|---|
| 06/18/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/919,153 | SCHRECKENGAST ET AL. |
| | Examiner | Art Unit | |
| | John B. Walsh | 2151 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *amdt of3/20/07* .

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

# DETAILED ACTION

## *Claim Objections*

1.      Claim 7 is objected to because of the following informalities:  Claim 7, line 2- replace

"system" with "machine" (to remain consistent with previous claim language).  Appropriate

correction is required.

## *Claim Rejections - 35 USC § 101*

2.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.      Claims 19-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.   The claimed subject matter lacks a practical application of a

judicial exception (abstract idea) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed

subject matter fails to produce a result that is limited to having real world value rather than a

result that may be interpreted to be abstract in nature as, for example, a thought, a computation,

or manipulated data. More specifically, the claimed subject matter provides for tracking usage of

users of the proprietary information utility for billing purposes. This produced result remains in

the abstract and thus fails to achieve the required status of having real world value. The

limitation of "tracking...for billing purposes" appears to be a step and there is no real world

result that is realized. The step of tracking appears to be some computation or manipulation of

data. The recitation of "for billing" is not a positive limitation since the actual result of billing a

user is never realized.

## *Claim Rejections - 35 USC § 102*

4.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.     Claims 1-18 and as best understood claims 19-27 are rejected under 35 U.S.C. 102(b) as

being anticipated by Amazon.com.

As concerns claim 1, a proprietary information utility comprising: an interface (a

computer) that provides outside entities connection to the proprietary information utility; a

repository (storage medium storing the webpages and data) that contains proprietary

information, wherein the repository is compartmentalized by user identity and entitlement, so

that a first category of proprietary information is within private domains (private data) available

to only a single user and a second category of proprietary information is within domains to

which multiple users (public data) may be granted use in response to paying a subscription fee

(subscription of a magazine) to use particular proprietary information within the second

category of proprietary information; application services (searching the webpages);  a security

system (secure webpages and data), that limits access of each user connecting to the proprietary

information utility to proprietary information to which each user is entitled, the proprietary

information to which each user is entitled being accessed through use of the application

services; and, a billing system (billing system for purchasing products/services from website)

for tracking usage by users of the proprietary information utility for billing purposes.

As concerns claim 2, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support software (website runs off software).

As concerns claim 3, a proprietary information utility as in claim 1 wherein the application services include services to perform at least one of the following activities related to patents: help identify patentable ideas; create patent disclosures; manage pending patents; manage research logs; and, research existing patents (search for books on patents).

As concerns claim 4, a proprietary information utility as in claim 1 wherein the application services include at least one of the services listed below: decision support software; software for troubleshooting products; system configuration services; diagnostic services; planning services; selection services; authoring tools that help authors generate appropriate software models; learning services for data-mining and the ongoing evolution of models; business intelligence services; version management services; presentation services; brokering services; stock selection services; investment portfolio troubleshooting services; investment portfolio selection services; services to troubleshoot devices; medical diagnosis services; services that predict failure and behavior; purchasing decision services; consulting services; skills gap analysis services; translation services for translating decision support models from one underlying technology to another; enterprise resource planning services; and, customer relationship management services (search for books on investment portfolio).

As concerns claim 5, a proprietary information utility as in claim 1 wherein the first category of proprietary information contains health records and the application services include services to provide services for supporting healthcare and patients, without revealing private information (books on health in a users cart).

As concerns claim 6, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes proprietary information within at least one

of the areas listed below: decision support models; and, models associated with troubleshooting

products (books on decision support models).

As concerns claim 7, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes decision support models that are based on at least

one of the technologies listed below: Bayesian networks; neural networks; case-based systems;

model-based systems; rule-based systems; fuzzy systems; decision trees; genetic algorithms;

Monte Carlo Markov chains; clustering algorithms; Monte Carlo optimization; simulated

annealing; pattern matching; influence diagrams; online analytical processing; collaborative

filtering; linear programming; machine learning; and, time series (books on Bayesian networks).

As concerns claim 8, a proprietary information utility as in claim 1 wherein the interfaces

allows users to connect to the proprietary information utility using at least one of the following

deployment channels: wireless network; cellular phones; internet sites; applications embedded

in appliances; applications embedded in devices; applications embedded in vehicle

communication and information systems; applications embedded in intelligent agents; and,

applications embedded in memory modules (internet sites).

As concerns claim 9, a proprietary information utility as in claim 1 wherein the

application services include services to support the creation, maintenance, and deployment

of decision support models, in at least one of the following areas: data-mining; usage reports;

business intelligence reports; adaptive learning and refining of models; authoring wizards

particular to specific horizontal and vertical industries; and, quality benchmarks of models

(books on data-mining).

As concerns claim 10, a proprietary information utility as in claim 1 additionally

comprising: an application service registry that manages dynamic registration, access, use,

and disposal of the application services (site keeps of items viewed).

As concerns claim 11, a proprietary information utility as in claim 1 additionally

comprising: a proprietary information broker that maps semi-structured proprietary

information requests to a most appropriate proprietary information model and application

services that will operate on the most appropriate proprietary information model (website lists

related products to desired products).

As concerns claim 12, a proprietary information utility as in claim 1 wherein the security

system provides non-repudiation services in support of billing and reporting (billing information

entered on a secure site).

As concerns claim 13, a proprietary information utility as in claim 1 wherein the security

system provides privacy for all information transmitted outside of the proprietary information

utility, allowing proprietary services to make use of proprietary in formation utility without

revealing anything about users of the proprietary services and without revealing contents of data

moving between services (private data is secure not un-secure public data).

As concerns claim 14, a proprietary information utility as in claim 1 wherein the billing

system provides revenue to be generated using at least one of the following pricing schemes:

pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows;

subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a

magazine subscription).

As concerns claim 15, a proprietary information utility as in claim 1 additionally

comprising: a scaleable computing engine that runs services across many pieces of

information (search engine for website).

As concerns claim 16, a proprietary information utility as in claim 1 additionally

comprising: a computing engine, the computing engine being used to translate information from

an author into a utility-native proprietary information format that can be used by a least a subset

of application services within the proprietary information utility (search terms entered into

search engine on website).

As concerns claim 17, a proprietary information utility as in claim 1 wherein the billing

system calculates royalty payments due to authors when proprietary information of the authors

is used by the application services within the proprietary information utility (authors receive

royalty payments based on books sold).

As concerns claim 18, a proprietary information utility as in claim 1 additionally

comprising an application service registry that manages dynamic registration, access, use,

and disposal of the application services, the application service registry providing a service

catalog, a discovery mechanism, and a brokering interface that links with the proprietary

information broker and the security system to provide a custom view of available application

services; based on entitlement and visibility (wish list or items in cart or items resulting from a

search).

As concerns claim 19, a method comprising the following steps: (a) providing outside

entities connection to a proprietary information utility (connect to website); (b) storing

proprietary information within a repository, wherein the repository is compartmentalized by

user identity and entitlement (memory storing data relating to users; wish list; items ordered) so

that a first category of proprietary information is within private domains (private data) available

to only a single user and a second category of proprietary information is within domains to

which multiple users (public data) may be granted use in response to paying a subscription fee

(subscription of a magazine or newspaper) to use particular proprietary information within the

second category of proprietary information; (c) limiting access of each user connecting to the

proprietary information utility to proprietary information to which each user is entitled, the

proprietary information to which each user is entitled being accessed through use of application

services operating within the proprietary information utility (private data; users account),

wherein multiple users can be granted access to the same proprietary information (public users

may access books and items sold on website; wherein a private user may buy the same

products); and, (d) tracking usage of users of the proprietary information utility for billing

purposes (users cart on website).

As concerns claim 20, a method as in claim 19 additionally comprising the following

step: (e) managing dynamic registration, access, use, and disposal of the application services

(user sets up an account).

As concerns claim 21, a method as in claim 19 additionally comprising the following

step: (e) mapping semi-structured proprietary information requests to a most appropriate

proprietary information model and application services that will operate on the most appropriate

proprietary information model (website lists related products to desired products).

As concerns claim 22, a method as in claim 19 wherein step (c) includes providing

non-repudiation services in support of billing and reporting (user enters payment info).

As concerns claim 23, a method as in claim 19 wherein step (c) includes providing

privacy for all information transmitted outside of the proprietary information utility, allowing

proprietary services to make use of proprietary information utility without revealing anything

about users of the proprietary services and without revealing contents of data moving between

services (private data transmitted securely; entered on a secure webpage).

As concerns claim 24, a method as in claim 19 wherein step (d) includes providing

revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-

transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing;

and, price bundling (subscription based pricing for a user ordering a magazine subscription).

As concerns claim 25, a method as in claim 19 additionally comprising the following

step: (e) translating information from an author into a utility-native proprietary information

format that can be used by a least a subset of application services within the proprietary

information utility (webpage presents text from books in another format for viewing on the

webpage).

As concerns claim 26, a method as in claim 26 wherein step (d) includes calculating

royalty payments due to authors when proprietary information of the authors is used by

the application services within the proprietary information utility (author receives royalty

payments based on number of books sold).

As concerns claim 27, a method as in claim 19 additionally comprising the following

step: (e) providing a service catalog, a discovery mechanism to provide a custom view of

available application services, based on entitlement and visibility (user can search by topic).
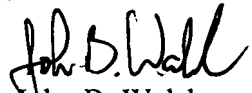

## *Conclusion*

6.      The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. See PTO-892. USPN 7,082,407 B1- (see col. 4, line 55).

7.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The

examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300. Information

regarding the status of an application may be obtained from the Patent Application Information

Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from

a USPTO Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John B. Walsh
Primary Examiner
Art Unit 2151